

Jason I. Garbell Novozymes North America 500 Fifth Avenue, Suite 1600 New York, NY 10110

In re Application of

Nielsen et al.

Application No. 09/831,656 : DECISION

PCT No.: PCT/DK99/00624

Int. Filing Date: 12 November 1999 : ON

Priority Date: 12 November 1998

Atty. Docket No.: 5753.204-US : PETITION

For: Transgenic Plant Expressing

Maltogenic Alpha-Amylase

This is in response to the "Petition Under 37 CFR 1.53" filed on 02 February 2005, which has been treated as a petition under 37 CFR 1.181.

BACKGROUND

This international application was filed on 12 November 1999, claimed an earliest priority date of 12 November 1998, and designated the United States. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the USPTO on 25 May 2000. The 30 month time period for paying the basic national fee in the United States expired at midnight on 14 May 2001 (since 12 May 2001 was a Saturday). On 11 May 2001, applicants filed *inter alia* the basic national fee.

On 21 June 2001, a Notification of Missing Requirements (Form PCT/DO/EO/905) and a Notification To Comply... (Form PCT/DO/EO/920) were mailed to applicants, indicating that "the application fails to comply with the requirements of 37 CFR 1.821 - 1.825" and requiring an initial or substitute paper copy or compact disk of the "Sequence Listing," as well as an amendment directing its entry into the specification.

On 23 August 2001, applicants filed a response.

On 19 October 2001, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating that the date of this application under 35 U.S.C. 371(c)(1), (2) and (4) is "09/02/2001."

On 02 February 2005, applicants filed the instant petition.

DISCUSSION

Petitioner requests that the USPTO "accord the filing date of the above-captioned application as the date of deposit of the application of May 11, 2001," arguing that

This application was filed under 35 U.S.C. 371 on May 11, 2001. All the requirements necessary for obtaining a filing date were complied with as of filing. As indicated in the cover sheet, a copy of the international application (PCT/DK99/00624) was communicated by the International Bureau on June 2, 2001. The international application contained a paper copy of the Sequence Listing. As all requirements were met at filing, the Application should have been accorded the filing date as of the date of deposit of May 11, 2001. However, the USPTO has mistakenly accorded a filing date of September 2, 2001, and appropriate correction is therefor requested.

Review of the application history reveals that applicants satisfied the requirements of 35 U.S.C. 371(c)(1), (2) and (4) on 11 May 2001. Therefore, the Notice of Acceptance (Form PCT/DO/EO/903) mailed on 19 October 2001 and the filing receipt were in error, and they are hereby **VACATED**.

DECISION

The petition under 37 CFR 1.181 is **GRANTED**, for the reasons described *supra*.

This application is being returned to the National Stage Processing Branch for further processing consistent with this decision, including the preparation and mailing of a new Notice of Acceptance (Form PCT/DO/EO/903) and a new filing receipt reflecting a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date and, on the filing receipt, a "filing date," of 11 May 2001.

Daniel Stemmer
PCT Legal Examiner

PCT Legal Office

George M. Dombroske PCT Legal Examiner

PCT Legal Office

Tel: (571) 272-3283 Fax: (571) 273-0459



Attorney Docket No.: 5753.204-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371

Box PCT Commissioner for Patents Washington, DC 20231

Sir:

This is a request for filing a patent application under 35 U.S.C. 371 of the international application identified below:

INTERNATIONAL APPLICATION NO. PCT/DK99/00624		INTERNATIONAL FILING DATE November 12, 1999		PRIORITY DATE CLAIMED November 12, 1998
	Al	PPLICANT	(S)/INVENTOR(S)	
Given Name (First and middle (if any))		Name or name		Residence r State or Foreign Country)
1. Jack Bech 2. Søren	1. Nielsen 2. Kjærulff		1. DK-2900 Hellerup, Denmark 2. DK-2720 Vanløse, Denmark	
	T	TLE OF T	HE INVENTION	
Transgenic Plant Expres	sing Malto	genic Alph	na-Amylase	

- 1. This is a first submission of items concerning a filing under 35 U.S.C. 371
- 2. This is an express request to begin national examination procedures (35 U.S.C. 371(f)).
- 3. The US has been elected by the expiration of 19 months from the priority date (Article 31).
- 4. A copy of the International Application as filed (35 U.S.C. 371(c)(2)) has been communicated by the International Bureau on June 2, 2001.
- An oath or declaration of the inventors is submitted herewith.
- An Assignment and Recordation Form Cover Sheet are submitted herewith.
- 7. A Preliminary Amendment is submitted herewith.
- 8. The assignee of the present application is:

Novozymes A/S Krogshoejvej 36 DK-2880 Bagsvaerd Denmark

U9/831656 June Rec'd PCT/PTO 1 1 MAY 2001

Applicants request that the assignee information be included in the published patent application.

9. Direct all correspondence to Customer Number 25908:



10. The following fees are submitted:

BASIC NATIONAL FEE (37 CFR 1.492(a)(1)-(5)):

Search Report has been prepared by the EPO or JPO

\$ 860

CLAIMS FEE

Total Claims: 20-20 = 0 x 18 =	\$ 0
Independent Claims: 6 - 3 = 3 x 80 =	\$ 240
Total Claims Fee:	\$ 240
FEE FOR RECORDING ASSIGNMENT	\$ 40

TOTAL NATIONAL FEE

\$1,140

11. Please charge the required fee, estimated to be \$1,140, to Novozymes North America, Inc., Deposit Account No. 50-1701. A duplicate of this sheet is enclosed.

Respectfully submitted,

Date: May 11, 2001

Jason I. Garbell, Reg. No. 44,116 Novozymes North America, Inc. 405 Lexington Avenue, Suite 6400 New York, NY 10174-6401

(212) 867-0123

WORLD INTELLECTUAL PROPERTY ORGANIZATION International Bureau



INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(51) International Patent Classification 7: WO 00/29591 (11) International Publication Number: C12N 15/82, 15/55, 5/10, A01H 5/00 (43) International Publication Date: 25 May 2000 (25.05.00) PCT/DK99/00624 (81) Designated States: AE, AL, AM, AT, AU, AZ, BA, BB, BG, (21) International Application Number: BR, BY, CA, CH, CN, CR, CU, CZ, DE, DK, DM, EE, (22) International Filing Date: 12 November 1999 (12.11.99) ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, NO, NZ, PL, PT, RO, RU, (30) Priority Data: SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, TZ, UA, UG, PA 1998 01478 12 November 1998 (12.11.98) US, UZ, VN, YU, ZA, ZW, ARIPO patent (GH, GM, KE, LS, MW, SD, SL, SZ, TZ, UG, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, 10 March 1999 (10.03.99) US

(71) Applicant (for all designated States except US): NOVO NORDISK A/S [DK/DK]; Novo Allé, DK-2880 Bagsværd

(72) Inventors; and

60/123,643

(75) Inventors/Applicants (for US only): NIELSEN, Jack, Bech [DK/DK]; Ole Olsens Allé 12, DK-2900 Hellerup (DK). KJÆRULFF, Søren [DK/DK]; Kongsdalsvej 47, DK-2720 Vanløse (DK).

(74) Common Representative: NOVO NORDISK A/S; Corporate Patents, Novo Alle, DK-2880 Bagsværd (DK).

Published

With international search report.

Before the expiration of the time limit for amending the claims and to be republished in the event of the receipt of amendments.

BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU,

MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, Cl, CM,

GA, GN, GW, ML, MR, NE, SN, TD, TG).

(54) Title: TRANSGENIC PLANT EXPRESSING MALTOGENIC ALPHA-AMYLASE

(57) Abstract

A transgenic plant cell expressing a maltogenic amylase (such as Novamyl®) or a beta-amylase; a transgenic plant regenerated from said cell; seeds generated from such plant where said seeds comprise a maltogenic amylase or a beta-amylase and the use of said seeds, optionally in ground form, for catalyzing an industrial process, such as e.g. in baking. The maltogenic amylase providing an anti staling effect in bread produced from the seeds in question.

PORM PCT/DO/EO/905 (March 2001)

Commissioner for Petents, Bos PCT nited States Petent and Tredement Office Washington, D.C. 2023

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104	ebbrication (t	retembly by the I	nternational application no	mper and interns	donal filing date). A
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7. The Article 1	y amendments	are cancelled since	e a translation was not pr	ovided by the app	ropriste 20 (37 CFR 1.494(d))
or 30 (37 CFR 1.49	5(d)) months f	rom the priority d	ate.		• • • • • • • • • • • • • • • • • • • •
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Applicant is remind	ed that any cor	namunication to Ch	e United States Patent and	Trademark Office	must be mailed to the .
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CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant has submitted papers under 35 U.S.C. 371 to enter the national stage in the United States of America. The items indicated below, however, are missing. The period within which to correct the deficiency noted below and avoid abandonment is set forth in the accompanying Notification.

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following

(Casorido).	
The application fails to comply with the	ne requirements of 37 CFR 1.821-1.825.
This application does not contain, a ":	Sequence Listing" as a separate part of the
disclosure on paper copy or compact	disc, as required by 37 CFR 1.821(c).
A copy of the "Sequence Listing" in o	omputer readable format has not been submitted as
required by 37 CFR 1.821(c).	
	computer readable form has been submitted. The
37 CFR 1.822 and/or 1.832, as indica	, however, does not comply with the requirements of ted on the attached marked-up copy of the "Raw
	been filed with this application has been found to be
damaged and/or unreadable as indicat substitute computer readable form mu	ed on the attached CRF Diskette Problem Report. A st be submitted as required by 37 CFR 1.825(d).
	e "Sequence Listing" is not the same as the
	ence Listing* as required by 37 CFR 1.821(e).
Other:	
An initial or substitute paper copy or amendment directing its entry into the A statement that the contents of the pare the same and, where applicable, i 1.821(e), 1.821(f), 1.821(g), 1.825(b)	aper or compact disc and the computer readable form neiude no new matter, as required by 37 CFR or 1.825(d).
FOR QUESTIONS REGARDING COMPLIANG	CE WITH THESE REQUIREMENTS, PLEASE
(703) 308-4216, for Rules interpretation	L.
(703) 308-4212, for CRF submission he	•
(703) 287-0200, for PatentIn software h	elp.
·	Telephone: (753 396-349)
FORM PCT/DO/EO/920 (March 2001)	Telephone:

Rec'd PCT/PTO 23 AUG 2001

Attorney Docket No.: 5753.204-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nielsen et al.

Confirmation No:

Serial No.: 09/831,656

Group Art Unit: To Be Assigned

Filed: May 11, 2001

Examiner: To Be Assigned

For: Transgenic Plant Expressing Maltogenic Alpha-Amylase

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

Box PCT

Commissioner for Patents Washington, DC 20231

Sir:

I hereby certify that the attached correspondence comprising:

- 2. Response to Notice to Comply with Sequence Rules
- 3. Sequence Listing
- 4. Copy of Notice to Comply with Sequence Rules
- 5. Disk Containing Sequence Listing

is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Box PCT Commissioner for Patents Washington, DC 20231

on August 21, 2001.

Kelley O'Patry

(name of person mailing paper)

(signature of person mailing paper)

Commissioner For Patents, Box PCT, United States Patent and Trademark Office, Washington, D.C. 20231, www.uspto.gov

U.S. APPLICATION NUMBER NO. FIRST NAMED APPLICANT ATTY. DOCKET NO.

09/831,656 Jack Bech Nielsen 5753.204-US

INTERNATIONAL APPLICATION NO.

PCT/DK 99/00624

125908

NOVOZYMES NORTH AMERICA, INC.

11/12/1999 11/12/1998

25908 NOVOZYMES NORTH AMERICA, INC. C/O NOVO NORDISK OF NORTH AMERICA, INC. 405 LEXINGTON AVENUE, SUITE 6400 NEW YORK, NY 10174

Date Mailed: 10/19/2001

NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.494 OR 1.495

The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as a Designated Office (37 CFR 1.494), has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.

The United States Application Number assigned to the application is shown above and the relevant dates are:

09/02/2001

DATE OF RECEIPT OF 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) REQUIREMENTS

09/02/2001

DATE OF RECEIPT OF ALL 35 U.S.C. REQUIREMENTS

A Filing Receipt (PTO-103X) will be issued for the present application in due course. THE DATE APPEARING ON THE FILING RECEIPT AS THE "FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35.U.S.C. 371 REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE. The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363). Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

The following items have been received:

- U.S. Basic National Fee
- Biochemical Sequence Diskette
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Oath or Declaration
- Preliminary Amendments
- Request for Immediate Examination



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nielsen et al.

Confirmation No: 7015

Serial No.: 09/831,656

Group Art Unit: 1638

Filed: May 11, 2001

Examiner: Kallis, Russell

For: Transgenic Plant Expressing Maltogenic Alpha-Amylase

RECEIVED

PETITION UNDER 37 CFR 1.53

1 O FEB 2005

Mail Stop Petition **Commissioner for Patents** P.O. Box 1450 Alexandria, VA 22313-1450

Legal Staff International Division

Sir:

1

Applicants hereby petition the Commissioner to accord the filing date of the abovecaptioned application as the date of deposit of the application of May 11, 2001.

This Application was filed under 35 U.S.C. 371 on May 11, 2001. All the requirements necessary for obtaining a filing date were complied with as of filing. As indicated in the cover sheet, a copy of the international application (PCT/DK99/00624) was communicated by the International Bureau on June 2, 2001. The international application contained a paper copy of the Sequence Listing.

As all requirements were met at filing, the Application should have been accorded the filing date of the date of deposit of May 11, 2001. However, the USPTO has mistakenly accorded a filing date of September 2, 2001, and appropriate correction is therefore required.

Please charge the required fee under 37 C.F.R. 1.17(h), estimated to be \$130.00, to Novozymes North America, Inc., Deposit Account No. 50-1701. A duplicate of this sheet is enclosed.

Respectfully submitted,

Date: January 31, 2005

09831656

Jason I. Garbell, Reg. No. 44,116 Novozymes North America, Inc. 500 Fifth Avenue, Suite 1600

New York, NY 10110

(212) 840-0097

02/03/2005 JBRLINA2 00000073 501701

130.00 DA

01 FC:1464

Attorney Docket No.: 5753.204-US

COMBINED DECLARATION FOR UTILITY PATENT APPLICATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

TRANSGENIC PLANT EXPRESSING MALTOGENIC ALPHA-AMYLASE

(Title of the Invention)

me specification of which
is attached hereto
OR
[x] was filed on (11/12/1999 as PCT International Application Number PCT/DK99/00624 an
was amended on (MM/DD/YYYY) (if applicable).
I hereby state that I have reviewed and understand the contents of the above-identified specification, including the
claims, as amended by an amendment referred to above.
acknowledge the duty to Asclose information which is material to patentability as defined in 37 CFR 1.5

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international applications(s) for patent or inventor's certificate or of any PCT international applications(s) which designated at least one country other than the United States of America, listed below and have also identified below any foreign application(s) for patent or inventor's certificate, or any PCT international application(s) having a filing date before that of the application(s) on which priority is claimed:

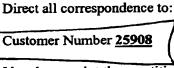
of the prior application and the national or PCT international filing date of the continuation-in-part application.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Claimed
PA 1998 01478	Denmark	11/12/1998	[X]YES []NO []YES []NO []YES []NO []YES []NO

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date
60/123,643	03/10/1999
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I hereby appoint the practitioners at the above mentioned customer number as my/our attorney(s) or agent (s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME	OF SOLE OR FIRST INVENTOR
Given Name (first and middle [if any])	Jack Bech
Family Name or Surname	Nielsen / / /
Inventor's Signature	THEK B. W.L.
Date	17/19/2001
Residence: City, State, Country	Hellerup
Citizenship	Danish UNX
Mailing Address	Ole Olsens Allé 12
City, State, Zip, Country	DK-2900 Hellerup, Denmark

NAN	ME OF SECOND INVENTOR
Given Name (first and middle [if any])	Søren
Family Name or Surname	Kjærulff
Inventor's Signature	19/4-261
Date	19/4-2601
Residence: City, State, Country	Vanløse
Citizenship	Danish
Mailing Address	Kongsdalsvej 47
City, State, Zip, Country	DK-2720 Vanløse, Denmark



Name/Number: 09831656 Total Records Found: 10

Start Date: Any Date End Date: Any Date

Accounting Date	Sequence Num.	Tran Type	Fee Code	Fee Amount Mailroom Date	Payment Method
05/16/2001	00000248	<u>1</u>	<u>970</u>	\$860.00 05/11/2001	DA 501701
05/16/2001	00000249	<u>1</u>	<u>964</u>	\$240.00 05/11/2001	DA 501701
05/16/2001	00000250	<u>1</u>	<u>581</u>	\$40.00 05/11/2001	DA 501701
05/07/2004	00000005	1	<u>1401</u>	\$330.00 05/06/2004	DA 501701
05/07/2004	00000006	<u>1</u>	<u>1253</u>	\$950.00 05/06/2004	DA 501701
07/28/2004	0000001	<u>1</u>	<u>1402</u>	\$330.00 07/26/2004	DA 501701
07/28/2004	00000002	<u>1</u>	<u>1251</u>	\$110.00 07/26/2004	DA 501701
02/03/2005	00000168	<u>1</u>	<u>1501</u>	\$1,400.00 02/02/2005	DA 501701
02/03/2005	00000169	1	<u>8001</u>	\$3.00 02/02/2005	DA 501701
02/03/2005	00000170	1	<u>1464</u>	\$130.00 02/02/2005	DA 501701

Attomey Docket No. 5753.204-US

PATENT

IN THE UNITED STATED DESIGNATED/ELECTED OFFICE (DO/EO/US)

INTERNATIONAL APPLICATION NO.: PCT/DK99/00624

INTERNATIONAL FILING DATE: November 12, 1999

PRIORITY DATE: November 12, 1998

TITLE: Transgenic Plant Expressing Maltogenic Alpha-Amylase

APPLICANT(S) FOR RO/US: Nielsen et al

EXPRESS MAIL CERTIFICATE

Box PCT Commissioner for Patents Washington, DC 20231

Sir:

Express Mail Label No. EL 739103098 US

Date of Deposit: May 11, 2001

I hereby certify that the following attached papers or fee

- Transmittal Letter to the DO/EO/US (in duplicate)
- 2. Preliminary Amendment
- 3. Recordation Form Cover Sheet
- 4. Assignment
- 5. Executed Combined Declaration and Power of Attorney

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231.

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